

REMARKS

In the Official Action of September 14, 2005, claims 1-26 have been rejected under 35 U.S.C. 103(a) as obvious over Perdelwitz, Jr. et al. (U.S. Patent No. 5,968,855) in view of Ahr et al. (U.S. Patent No. 4,323,069). This ground of rejection is respectfully traversed.

The Examiner has alleged that it would be obvious to modify the primary reference to Perdelwitz et al. by replacing the 40 gsm carded thermobonded transfer layer of Perdelwitz, Jr. with the apertured film layer of Ahr al., and that the motivation to do so would be to reduce the rewet of the absorbent article.

In response to the Examiner's position, applicant has previously filed the Declaration of Prelo Hood providing data comparing the rewetting characteristics of the articles described in Perdelwitz, Jr. and the present invention. The intent of the Declaration is to demonstrate enhanced or unexpected results of the present invention to thereby rebut a prima facie case of obviousness resulting from a combination of Perdelwitz, Jr. et al. and the Ahr et al. references. In other words, if the applicant can demonstrate more than just an expected improvement in properties by using an apertured film, as compared to the carded thermoplastic transfer layer used in Perdelwitz, Jr., then applicant has rebutted any prima facie case of obviousness which may be asserted by the Examiner.

The prima facie case of obviousness, in the present circumstance, is alleged to result from the combination of the Perdelwitz et al. and Ahr et al. references. However even though one skilled in the art may have been motivated to make a particular substitution, if the results of the substitution are unexpected, then this unexpected improvement in properties is sufficient to rebut an inference that a prima facie case of obviousness has been established. See *In re Corkill*, 226 USPQ 1005 (Fed Cir. 1985), and *In re Chupp*, 2 USPQ2d 1437 (Fed. Cir. 1987). See also MPEP 716.02.

Turning now to the Declaration, it is apparent from Exhibit B of Appendix I that the use of an apertured film in accordance with the present invention is unexpectedly superior to the use of a nonwoven transfer layer as described in the Perdelwitz et al. reference, in terms of the rewetting characteristics of each product. Moreover, applicant

submits that this difference is more than one of mere degree. See *In re Wagner*, 152 USPQ 552, 560 (CCPA 1067). Compare, for instance, the results of each product using the Perdelwitz et al. test method: 0.99 grams (average, Perdelwitz et al.) v. 0.28 grams (average, present invention). Also, the comparative results of each product after a third insult are even more striking: 21.77 grams (average, Perdelwitz et al.) v. 1.27 grams (average, present invention).

The Examiner contends that the articles of the present invention incorporating an apertured film should be compared to hypothetical absorbent articles prepared by substituting a component of the Ahr et al. reference (apertured film) in the articles of Perdelwitz et al. However, the question to be addressed is whether such a hypothetical article would have been prepared by one skilled in the art having these references before him or her. It is this proposition that applicants have attempted to rebut by the submission of evidence of unexpected results. See, for instance, *In re Geiger*, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987), holding that applicant is not required to compare the claimed invention with subject matter that does not actually exist in the prior art. See also *In re Chapman*, 148 USPQ 711, 714 (CCPA 1966), holding that applicant is not required to compare the claimed invention with a product which may be suggested by combining the references cited by the Examiner since this would require a comparison of the invention with the invention itself. MPEP 716.02(e).

Accordingly, applicant respectfully submits that a fair and objective consideration of the evidentiary record established during the prosecution of this application, and particularly the Declaration of Prelo Hood, would lead one skilled in the art to conclude that any inference of obviousness in view of the cited prior art has been successfully rebutted by evidence of unexpected results.

In view of the aforementioned facts and reasons, the present application is now believed to overcome the remaining rejections, and to be in proper condition for allowance. Entry of the foregoing amendment, and reconsideration and withdrawal of the rejections, is respectfully solicited. The Examiner is invited to contact

the undersigned at the telephone number listed below to discuss any matter pertaining to the status of this application.

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Respectfully submitted,

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